REMARKS

Claims 1-20 were originally filed in the present application.

Claims 1, 6, 10, 11, 16, 17 and 18 were previously amended.

Claims 1-10 were rejected in the February 22, 2005 Office Action.

No claims have been allowed.

Reconsideration of the claims is respectfully requested.

In Sections 1 and 2 of the February 22, 2005 Office Action, the Examiner rejected Claims 1, 2, 5-7, 11 and 12 under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 6,223,028 to *Chang et al.* (hereafter, simply *"Chang"*) in view of U. S. Patent No. 6,622,017 to *Hoffman* (hereafter, simply *"Hoffman"*). In Section 3 of the February 22, 2005 Office Action, the Examiner rejected Claims 10, 16, 17 and 20 under 35 U.S.C. §103(a) as being unpatentable over the *Chang* and *Hoffman* references in view of U. S. Patent No. 5,819,177 to *Vucetic et al.* (hereafter, simply *"Vucetic"*). In Section 4 of the February 22, 2005 Office Action, the Examiner rejected Claims 3, 4, 8, 9, 13-15, 18 and 19 under 35 U.S.C. §103(a) as being unpatentable over the *Chang, Hoffman,* and *Vucetic* references in view of U. S. Patent No. 6,314,282 to *Weber et al.* (hereafter, simply *"Weber"*).

Initially, the Applicants note that the filing date of the *Hoffman* reference (April 24, 2000) is later than the filing date of the present application (April 4, 2000). While the *Hoffman* reference claims priority to provisional application 60/185,131 filed on February 24, 2000, the Office Action does not demonstrate that the passages relied upon in the Examiner's rejections are found in the

provisional application.   For the Examiner's convenient reference, a copy of provisional application 60/185,131 is attached.

The final Office Action, in the rejection of independent claims 1, 6, 11, and 16, relies on *Hoffman*'s claim 1, that includes the language "automatically provisioning at least one element of the wireless communication network to activate a subscription service corresponding to the selected feature." Applicant notes that these claims do not appear in provisional application 60/185,131, and so were not filed before the filing date of the instant application.

Moreover, Applicant notes that the language and function as in *Hoffman*'s claim 1 are not taught in provisional application 60/185,131 (and indeed do not appear to be taught in *Hoffman* itself, and there certainly is not an enabling teaching). Page 9 of provisional application 60/185,131 describes the "provisioning database 27" which is used by the service operator to provision basic service in the mobile station. Page 11 of provisional application 60/185,131 describes the "feature program database 29" that has plug-in modules to enable various features. However, the only reference to provisioning with relation to these features appears to be page 11, lines 14-16, which indicate "since the carrier has provisioned the station 5 to operate on the network 3...." There is no teaching or suggestion that any provisioning is done automatically. The only provisioning mentioned is performed by the carrier (service operator), and since no other teaching is made, it must be assumed that this is done in a conventional, manual fashion.

As such, the rejections of all independent claims rely on a non-enabling teaching found only in the claims of a reference with a filing date after the filing date of the instant application. The

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Examiner has made no showing that any supporting teaching is found in provisional application

60/185,131. As such, all independent claims, and therefore all dependent claims, should be allowed.

Many other distinctions are present. The Applicants direct the Examiner's attention to Claim

1, which contains the unique and novel limitations emphasized below:

> 1. (Currently Amended) For use in a wireless network comprising a plurality
> of base stations, each of said base stations capable of communicating with a
> plurality of mobile stations, a service provisioning system capable of provisioning
> a first one of said plurality of mobile stations comprising:
> a database capable of storing a service provisioning file comprising <u>a mobile
> station service provisioning program in interpreted byte-code format</u>; and
> a provisioning controller coupled to said database capable of receiving a
> notification indicating that said first mobile station is unprovisioned and further
> capable, in response to receipt of said notification, of retrieving said service
> provisioning file from said database and transmitting said service provisioning file
> to said first mobile station, wherein receipt of said service provisioning file <u>causes</u>
> <u>said first mobile station to automatically execute said mobile station service</u>
> <u>provisioning program</u> in said service provisioning file, <u>execution of said mobile</u>
> <u>station service provisioning program automatically provisioning said first mobile</u>
> <u>station</u> without further interaction from a service operator.
> (*emphasis added*)

The Applicants respectfully assert that the above-emphasized limitations are not disclosed in the

Chang reference, the *Hoffman* reference, or in the combination of the *Chang* reference and the

Hoffman reference.

The Examiner asserts that *Chang* describes a database capable of storing a service

provisioning file comprising a mobile station service provisioning program in interpreted byte-code

format at column 4, lines 34-39, and Table 1. The cited passage states:

> With reference now to Table I, there is depicted a list of parameters in a protocol
> capability response message from a mobile to a base transceiver station over the air

within mobile telephone communication network 10, in accordance with a preferred embodiment of the present invention.

Table I is a list of message fields and their lengths. As such, the cited passage and table describe a message sent from a mobile station to a base transceiver station, rather than a database as recited in Claim 1.

Additionally, the Office Action argues that *Hoffman* shows a system which retrieves a service provisioning file from a database, transmits the file to a mobile station, wherein receipt of the file causes the mobile station to automatically execute a mobile station service provisioning program in interpreted byte-code format in the file, the execution of the program by the mobile station automatically provisioning the mobile station without further interaction from a service operator. The Examiner cites the final three clauses of Claim 1 of the *Hoffman* reference, at column 16, lines 38-48, in support of this argument. That claim recites a method which includes the steps of:

> retrieving one of the executable program modules from the database, the retrieved module corresponding to the selected feature;
> downloading the retrieved module into the substantial portion of the program memory in the one programmable wireless communication terminal, to enable the one wireless communication terminal to implement the selected feature; and
> automatically provisioning at least one element of the wireless communication network to activate a subscription service corresponding to the selected feature.

The downloaded programs are described as plug-in software modules, written to the application program interface (API) specifications of the core software of the mobile station. *See Hoffman, col. 2, lines 32-34.* The mobile station includes a microprocessor and flash memory for storing the microprocessor's core programming and plug-in feature modules. *See Hoffman, col. 12,*

lines 48-57. The feature modules are written to the specifications of the hardware and the API of the particular type of handset. *See Hoffman, col. 15, lines 49-51.* As such, the *Hoffman* reference does not teach a service provisioning system in which a mobile station automatically executes a mobile station service provisioning program in interpreted byte-code format, as recited in independent Claim 1.

Furthermore, when the *Hoffman* reference describes the provisioning of a mobile station, it does not teach that execution of the downloaded program by the mobile station automatically provisions the mobile station without further interaction from a service operator. On the contrary, *Hoffman* describes the carrier's customer service center as performing the provisioning of a mobile station. *See Hoffman, col. 9, lines 25-27, and col. 10, lines 5-20.*

For these reasons, the Applicants respectfully assert that neither the *Chang* reference, the *Hoffman* reference, nor the combination of the *Chang* and *Hoffman* references teaches a service provisioning system comprising a database capable of storing a service provisioning file comprising a mobile station service provisioning program in interpreted byte-code format, and a mobile station which, upon receipt of the service provisioning file, automatically executes the mobile station service provisioning program to automatically provision the mobile station without further interaction from a service operator, as recited in independent Claim 1. Furthermore, the Applicants respectfully assert that the *Vucetic* and *Weber* references do nothing to overcome this shortcoming.

This being the case, Claim 1 presents patentable subject matter over the *Chang* reference and the *Hoffman* reference. Additionally, dependent Claims 2-5, which depend from Claim 1, contain all

of the unique and novel limitations recited in independent Claim 1. Claims 2-5 are therefore patentable over the *Chang* reference and the *Hoffman* and *Weber* references.

Furthermore, independent Claims 6, 11 and 16 recite limitations that are analogous to the unique and novel limitations recited in Claim 1. This being the case, Claims 6, 11 and 16 are patentable over the *Chang* reference and the *Hoffman* and *Vucetic* references. Dependent Claims 7-10, 12-15 and 17-20, which depend from Claims 6, 11 and 16, respectively, contain all of the unique and novel limitations recited in independent Claims 6, 11 and 16. Thus, Claims 7-10, 12-15 and 17-20 are patentable over the *Chang* reference and the *Hoffman, Vucetic* and *Weber* references.
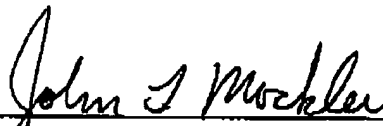
SUMMARY

The Applicants respectfully request reconsideration and allowance of pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,
DAVIS MUNCK, P.C.

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